



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,304	07/26/2000	Tsuyoshi Futamase	393032016800	7930

7590 12/05/2001

David L Fehrman
Morrison & Foerster LLP
555 West Fifth Street
Suite 3500
Los Angeles, CA 90013-1024

EXAMINER

DONELS, JEFFREY

ART UNIT	PAPER NUMBER
----------	--------------

2837

DATE MAILED: 12/05/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

P.S.

Office Action Summary

Application No.

09/626,304

Applicant(s)

FUTAMASE ET AL.

Examiner

Jeffrey Donels

Art. Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-361 is/are pending in the application.
- 4a) Of the above claim(s) see attachment is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) see attachment is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claims 1, 11, 12, 30, 32, 35, 38, 39, 59, 60, 79, 80, 85, 86, 91, 103, 104, 114, 119, 131, 143, 155, 167, 181, 193, 205, 217, 229, 241, 253-255, 267, 279, 291-306 are selected for examination. The remaining claims are withdrawn from consideration.

Claims 1, 11, 12, 30, 32, 39, 59, 60, 79, 80, 85, 86, 91, 103, 114, 119, 131, 155, 217, 229, 241, 253-255, 267, 279, 291-295, 297, 299-306 are rejected.

Claims 32, 38, 143, 167, 181, 193, 205, 296, 298 are allowed.

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claim 114 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 114, the phrase "operated to exchange a talk voice with a ringing tone" is not clear. Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1,11,12,30,292-295 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Japanese Patent Application No. 09101786.

Regarding Claims 11 and 293, the envelope processing reads as the recited effect processing.

Regarding Claims 12,30,294,295, the DSP reads on the second processor.

Claims 59,60,79,300-302 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Imai et al.

See especially Figs. 1,4,7, and 14.

Claim 104 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kim et al.

Claims 119,131,155,217 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Armanto et al. See esp. Cols. 12 and 13.

Claim 229,241,253,254 is rejected under 35 U.S.C. 102(a) as being clearly anticipated by Valentine et al. See especially Col. 4 lines 15-27.

Claims 279 and 291 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Ito.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,39,60,91,292,299,301,306 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ide.

Ide discloses a method of extending capability of music apparatus by networking which comprises all features claimed, but does not claim that the local terminal / electronic musical instrument is provided in a portable terminal. It has been held that a claimed device is not patentably distinguishable over a device known in the art because it has been made portable. See *In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952).

Regarding Claims 91 and 306, Ide does not explicitly disclose a creating and editing section as recited; however, the music data Imai uses is in the MIDI standard format, and Official Notice is taken that such editing and creating of MIDI data is notoriously old and well-known in the art of electronic music.

Claims 35 and 297 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ide in view of Kim et al.

Regarding Claims 35 and 297, Ide (applied in a similar manner as above) discloses all features claimed but does not explicitly disclose picture information and a video device as claimed. Kim et al. discloses a karaoke service method which comprises picture information and a video device (Col. 4 lines 32-64). It would have been obvious to one of ordinary skill in the art to adapt the Ide teachings with those of Kim et al., as both inventions are drawn towards music playback devices and so as to allow the users of an Ide device to use karaoke functionality.

Claims 35 and 297 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ide in view of Norio (Japanese Patent Application No. 09101786).

Regarding Claims 35 and 297, Norio (applied in a similar manner as above) discloses all features claimed but does not explicitly disclose picture information and a video device as claimed. Kim et al. discloses a karaoke service method which comprises picture information and a video device (Col. 4 lines 32-64). It would have been obvious to one of ordinary skill in the art to adapt the Norio teachings with those of Kim et al., as both inventions are drawn towards portable music playback devices and so as to allow the users of the Norio device to use karaoke functionality.

Claims 80,85,86,303-305 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imai et al. in view of Farris et al.

Imai (applied in a similar manner as above) discloses all features claimed but does not explicitly disclose compression of the music signal as recited. Farris et al. discloses a mobile download system which comprises MPEG compression of audio data sent to a mobile phone (Col. 15). Imai does not explicitly disclose a creating and editing section as recited; however, the music data Imai uses is in the MIDI standard format, and Official Notice is taken that such editing and creating of MIDI data is notoriously old and well-known in the art of electronic music. It would have been obvious to one of ordinary skill in the art to adapt the Imai teachings with the Farris teachings, as both inventions are narrowly directed towards the art of transmitting audio data over a network.

Claim 103 is rejected under 35 U.S.C. 103(a) as being unpatentable over Imai et al.

Imai (applied in a similar manner as above) discloses all features claimed but does not explicitly disclose a creating and editing section as recited; however, the music data Imai uses is in the MIDI standard format, and Official Notice is taken that such editing and creating of MIDI data is notoriously old and well-known in the art of electronic music. It would have been obvious to one of ordinary skill in the art to adapt the Imai teachings with such teachings, so as to allow a user greater control over the music being played.

Claims 255 and 267 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al.

Kim et al. (applied here in a similar manner as above) discloses all features claimed but does not explicitly disclose a removable compact memory medium as recited. Not only has it been held that a claimed device is not patentably distinguishable over a device known in the art because it has been made removable (see *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961)), but Official Notice is taken that making the memory medium removable would have been notoriously old and well-known in the art and obvious for the purpose of making it easier for the user to change music information.

Art Unit: 2837

Claims 32,38,167,181,193,205,296,298 are allowed.

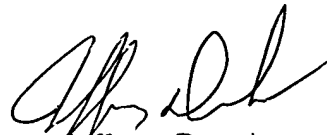
Claim 114 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kato, Okamura, Lee, Janky, Harada et al., and Rajchel are further cited to show related teachings in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Donels whose telephone number is 703-308-3115. The examiner can normally be reached on 9 hour days, first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Nappi can be reached on 703-308-3370. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.



Jeffrey Donels
Primary Examiner
Art Unit 2837

jwd
November 19, 2001